

**REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to claim 35 because "filed" should be --field--. In response, claim 35 has been amended as suggested by the Examiner. Accordingly, it is respectfully requested that the objection to claim 35 be withdrawn.

In the Official Action, the Examiner rejects claims 33-35 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,398,721 alone or in view of the claims of U.S. Patent No. 6,661,571. Although, the claims of U.S. Patent Nos. 6,398,721 and 6,661,571 indicated by the Examiner in the rejection do not recite an electric probe joint provided on a wall near an eyepiece unit of the surgical microscope, in the interests of advancing prosecution, Applicants file herewith a terminal disclaimer disclaiming any portion of the term of a U.S. patent which eventuates from the present application which extends beyond the term of U.S. Patent No. 6,398,721. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 33-35 under the judicially created doctrine of obviousness-type double patenting.

In the Official Action, the Examiner rejects claims 33-35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner argues that the phrase "on a wall near an eyepiece unit" is vague because it may also pertain to a nearby wall on any console or panel or a wall in the room or a nearby room. In response, claim 33 has been amended to clarify that the surgical microscope has a microscope eyepiece unit for observing a region for treatment and that the electric probe joint is provided on an

outer wall of the microscope eyepiece unit. Claim 34 has been amended to be consistent with amended claim 33.

The Examiner also rejects claims 33-35 under 35 U.S.C. § 112, second paragraph, because the term “electric probe joint” is vague since a connector and its mating part taken together constitute an electrical connection or joint in common parlance. In response, Applicants respectfully traverse this portion of the rejection because it is well settled in U.S. Patent Law that an inventor can act as his own lexicographer and give any meaning to a claim term in the specification (Hoganas AB v. Dresser Indus., Inc., 9 F.3d 948, 951, 28 USPQ2d 1936, 1938 (Fed. Cir. 1993)). Furthermore, it is also well settled in U.S. Patent Law that claim terms are interpreted with regard to the specification (Phillips v. AWH Corp., 415 F.3d 1303, 1317 (Fed. Cir. 2005)). Therefore, since the electric probe joint is clearly defined and shown in the specification as the connector disposed on a wall of the microscope, such term is not vague under 35 U.S.C. § 112, second paragraph.

Accordingly, it is respectfully requested that the rejection of 33-35 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claim 33 under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in paragraphs [0006-0011] in the present specification (hereinafter “the admitted prior art”) in view of U.S. Patent No. 5,413,573 to Koivukangas (hereinafter “Koivukangas”) and U.S. Patent No. 6,106,521 to Blewett et al., (hereinafter “Blewett”). Additionally, the Examiner rejects claims 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art, Koivukangas and Blewett and further in view of U.S. Patent No. 5,505,203 to Deitrich et al., (hereinafter “Deitrich”). The Examiner argues that the admitted prior art shows all of the features of the claims with the

exception of the probe being connected to a wall of the microscope. The Applicants respectfully disagree with the Examiner's arguments.

With regard to Koivukangas, the same does not disclose an electrical connection for electrically powering the electric ultrasonic probe. Koivukangas only discloses a connection for the probe that identifies the type of probe connected. Koivukangas discloses that the identification connection can be electrical. Claim 33 has been amended to clarify that the electric probe joint electrically powers the ultrasonic probe. The amendment to claim 33 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment to claim 33.

With regard to the rejection of claim 33 under 35 U.S.C. § 103(a), independent claim 33 is not rendered obvious by the cited references because neither the admitted prior art nor the Koivukangas patent, whether taken alone or in combination, teach or suggest a microscopic surgery system having at least the features described above. Accordingly, claim 33 patentably distinguishes over the prior art and is allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 33 under 35 U.S.C. § 103(a).

With regard to the rejection of claims 34 and 35 under 35 U.S.C. § 103(a), since independent claim 33 patentably distinguishes over the prior art and is allowable, claims 34 and 35 are at least allowable therewith because they depend from an allowable base claim.

Further with regard to the rejection of claim 33 under 35 U.S.C. § 103(a), Applicants respectfully submit that there is no motivation or suggestion to combine Koivukangas with the teachings of the admitted prior art. Since the probe of Koivukangas is only disclosed as being connected to an articulating arm and not to an imaging device (e.g., a surgical microscope), there is no motivation or suggestion to combine the same with the

teachings of the admitted prior art. In this regard, the Examiner does not indicate any motivation or suggestion for combining Koivukangas with the admitted prior art (the Examiner only indicates a motivation for combining Deitrich with the other references).

The Federal Circuit, has repeatedly made it clear that although virtually all inventions are combinations of old elements and that an Examiner may often find every element of a claimed invention in the prior art, to prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness.<sup>1</sup> Applicants respectfully submit that the Examiner has not met this burden. Therefore, in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the Koivukangas reference with the admitted prior art, the Applicants respectfully submit that the rejections for obviousness under 35 U.S.C. § 103(a) lack the requisite motivation and must be withdrawn.

Further with regard to the rejection of claims 34 and 35 under 35 U.S.C. § 103(a), the Applicants respectfully submit that Blewett is non-analogous art and there is no motivation or suggestion to combine Blewett or Deitrich with any of the other cited references, particularly with the admitted prior art.

Blewett discloses a probe fixed to a channel of an endoscope. Applicants see no relevance between such an arrangement and electrically fixing the probe on an outer wall of the microscope eyepiece unit of a surgical microscope. Thus, Applicants respectfully submit that Blewett is non-analogous. In this regard, the Applicants respectfully submit that

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<sup>1</sup> See e.g., In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998)

Blewett is neither in the same field of endeavor as the microscopic surgery system of claims 34 and 35 nor is it reasonably pertinent to the problem faced by the inventor.<sup>2</sup>

Furthermore, Applicants respectfully submit that there is also no motivation or suggestion to combine the probe fixed to a channel of an endoscope of Blewett with the admitted prior art. Again, the Examiner does not indicate any motivation or suggestion for combining Blewett with the admitted prior art. Thus, again, Applicants respectfully submit that the Examiner has not met the burden of showing a motivation to combine the references that create the case of obviousness. Therefore, the Applicants respectfully submit that the rejection of claims 34 and 35 for obviousness under 35 U.S.C. § 103(a) lack the requisite motivation and must be withdrawn.

With regard to Deitrich, the Examiner argues that the same shows a holder for a probe and that its combination with the other references would be obvious so that they are out of the field of view of the probe. Applicants again disagree. The holder disclosed in Deitrich is located on a cart for holding endoscopic equipment. The cart is not used for observation during the surgical procedure and thus, the cart and any portions thereof can never be in the field of view. Therefore, the motivation for combining the references argued by the Examiner can have only been gleaned in hindsight from the present application. Applicants respectfully submit that such hindsight reasoning is impermissible and the rejection of claims 34 and 35 for obviousness under 35 U.S.C. § 103(a) lack the requisite motivation and must be withdrawn.

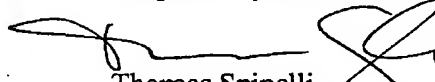
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<sup>2</sup> See, e.g., In re Clay, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992); In re Paulsen, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994); and Wang Labs., Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ 2d 1767 (Fed. Cir. 1993).

Furthermore, new claims 36 and 37 have been added to further define the patentable invention. New claims 36 and 37 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 36 and 37. Applicants respectfully submit that new claims 36 and 37 are at least allowable as depending upon an allowable base claim (33).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

  
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